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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,344	11/21/2003	William A. Taylor	3290-11	3317
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William Arthur Taylor			EXAMINER	
1326 Aspen Drive			THOMAS, ERIC M	
Evergreen, CO 80439				
			ART UNIT	PAPER NUMBER
			3714	
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			12/01/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/719,344

Applicant(s)

TAYLOR, WILLIAM A.

Examiner

Eric M. Thomas

Art Unit

3714

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-16 and 18-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-16 and 18-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/12/08 has been entered.

Response to Amendment

This is in response to the amendments filed on 6/12/08; claims 4, 12, 13, and 17 have been cancelled and claims 31 and 32 have been added. Claims 1 – 3 and 5 -11, 14 -16, and 18 - 32 are pending in the current application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1 – 3, 7, 14 – 16, 18 – 21, and 27 – 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Englman (U.S. 2003/0157978).**

Regarding claims 1 – 3, 16, 21, and 27 – 30, Englman provides a method of using a gaming machine that provides a player with a series of plays of a single game for a single wager, (par. 0001), wherein Englman further discloses in paragraphs [0001, 0007, and 0024], that the gaming machine provides a player with a series of plays of a game for a single wager, thus guaranteeing a variable period of play. Englman further discloses maintaining a count of plays of the single game that is provided to the player, which is shown in fig. 12, which reads "games remaining", which is viewed by the examiner as a count element that displays to the player how many games are remaining in the purchased series of plays. Englman further discloses a display, which is used to display a plurality of parameters that is related to the game, (fig. 12), wherein the gaming device receives a plurality of player initiated actions, (par. 0026), storing information that is related to the game, (par. 0027). Englman further discloses that the gaming machine receives a wager from a player to purchase a series of plays of the game, (par. 0029), wherein response the gaming machine provides a basic game, wherein the gaming machine generates at least one random event and provides an award to the player for a winning outcome, (par. 0030), wherein the winning outcome of the basic is based on symbol combinations of the random event, (par. 0033). As disclosed in the claimed invention, (par. 0086), game-termination symbols may be reel symbols. The examiner views this as a basic operation of a gaming machine that involves a purchased series of plays, wherein the event that if a player loses, a count of one of the purchased series of plays decreases based a symbol combination. The examiner views the losing symbol combination as game-termination symbols, wherein

in the event if the player continues to lose, the game eventually ends when the count of the purchased series of plays reaches zero. Englman further discloses that a player may receive free spins to be included in the purchased series of plays, (“+N games” par. 0052). The examiner views this as a game-extension symbol that increases the count of purchased series of plays provided to the player, wherein the gaming machine is capable of displaying the game results (par. 0026). Englman further discloses that a special outcome may occur when a special symbol appears on the reels, wherein the special outcome causes the machine to shift from a basic game to a bonus game (par. 0034). The examiner views this as a symbol that is neither a game-terminating symbol nor a game-extension symbol and does not affect the count of the purchased series of plays.

Regarding claim 7, Englman provides a method of playing a gaming machine that discloses a simulation that is related to the game (par. 0031).

Regarding claim 14, Englman provides a method of playing a gaming machine wherein an appearance of at least game – extension symbol is determined by data entered by the player (par. 0024).

Regarding claim 15, Englman provides a method of playing a gaming machine wherein the game is a slot machine, (fig. 1), which provides winning opportunities within a number of reel spins when a period of play is initiated (par. 0004).

Regarding claim 18, Englman provides a method of playing a gaming machine wherein a special symbol is displayed randomly (par. 0034).

Regarding claim 19, Englman provides a method of playing a gaming machine wherein the special symbol is displayed based on the outcome of game - play (par. 0034).

Regarding claim 31, Englman provides a method of playing a gaming machine that displays a special symbol, wherein a characteristic of the special symbol is used in a secondary or bonus game (par. 0034).

Regarding claim 32, Englman provides a method of playing a gaming machine that discloses that at the conclusion of the purchased series of plays, a bonus, "Power Play," is awarded to the player (par. 0053). The examiner views this as a secondary game occurring when the count reaches zero.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 5, 6, 8, 9 - 11, and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Englman (U.S. 2003/0157978).**

Regarding claims 5, 6, 8 - 11, and 20, Englman provides a method of playing a gaming machine, but is silent on the issue of including game - termination symbols that is related to a sports or ship theme, but instead discloses a board game theme ("Monopoly" par. 0064). At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use American

football or any kind of theme instead of the board game theme used by Englman because the Applicant has not disclosed that using a sports' theme provides an advantage or solves a stated problem. Therefore, it would have been prima facie obvious to modify Englman because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Englman. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the game – termination symbols relating to sports or ship theme into the art disclosed by Englman in order to increase player excitement while playing the gaming machine.

Claims 22 – 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Englman (U.S. 2003/0157978 in view of Slomiany (U.S. 6,612,927).

Regarding claims 22 - 26, Englman provides a method of playing a gaming machine in which determining the outcome of a game playing situation is classified as a win or loss in which the player loses a predetermined game if a loss occurs, (par. 0024), that includes a basic game and one more bonus games that are triggered by special symbols based on the outcome in the basic game, which increases the number of plays (par. 0024), wherein a player of the gaming device is awarded a winning outcome, which is shown on a primary or secondary display (par. 0026). It also includes a pay table, which indicates the player's reward for outcome of a win, along with the player's wager (par 0039). The payout amount is selectively increased based on the outcome of a win, or decreased based on the outcome of a loss, but Englman is silent on the issue of

altering the pay-table between plays. In a related art, however, Slomiany provides a method of playing a gaming machine that alters the pay-table randomly and is affected by an event that occurs in the game (col. 45, lines 11 – 30). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the teachings of Slomiany in the art disclosed by Englman in order to alter the pay-table of a gaming machine depending on the outcome of a win or loss.

Response to Arguments

1. Applicant's arguments filed 6/12/08 have been fully considered but they are not persuasive. Regarding claims 1, 11, and 16, Applicants argue that Englman does not disclose the element of claim 1, wherein "receiving, at the gaming machine, a single wager, wherein the single wager provides a player a plurality of plays of a single game. Applicants further argue that Englman does not guarantee a player a plurality of plays of a single basic game when a single wager is made because the basic game is interrupted by a bonus game, and that Englman does not specifically disclose a count element. The examiner respectfully disagrees. Englman's gaming machine, as stated in paragraphs [0001, 0007, and 0024], provides a player with a series of plays of a game for a single wager. In paragraph [0038], Englman further discloses the use of a "held bonus" feature during game play, wherein in the event if any bonus games are triggered during the basic slot game, the bonus games may be held in the bonus game meter (part 72 of fig. 3), thus not interrupting the basic slot game. Englman further discloses in fig. 12, a "games remaining" display that displays the number of games remaining for the purchased series of plays, which is viewed by the examiner as a count element that

displays to the player how many games are remaining in the purchased series of plays, wherein the number of purchased series of plays may decrease during game play if the outcome is a loss or increase if the player receives a game-extension symbol (" +N games" par. 0052). For the reasons stated, the examiner maintains these claim limitations obvious over Englman.

2. Regarding claims 22 - 26, Applicants argue that "neither Englman nor Slomiany disclose maintaining a count of the predetermined number of game plays." The examiner respectfully disagrees. As stated above, Englman discloses the gaming machine including a "games remaining" display that displays the number of games remaining for the purchased series of plays, which is viewed by the examiner as a count element which is viewed by the examiner as a count element that displays to the player how many games are remaining in the purchased series of plays, wherein the number of purchased series of plays may decrease during game play if the outcome is a loss, Englman further discloses that a player may receive free spins to be included in the purchased series of plays, (" +N games" par. 0052). The examiner views this as a game-extension symbol that increases the count of purchased series of plays provided to the player, thus possibly maintaining the or extending the number of purchased series of plays. For the reasons stated, the examiner maintains these claim limitations obvious over Englman.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric M. Thomas whose telephone number is (571) 272-1699. The examiner can normally be reached on 7a.m. - 3p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on (571) 272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Supervisory Patent Examiner, Art Unit 3714